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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/738,047	12/15/2000	Sergio Fernandez	FERNAND.004A	2321

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EXAMINER
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SINGH, SATWANT K

ART UNIT	PAPER NUMBER
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2626

DATE MAILED: 09/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	09/738,047	FERNANDEZ ET AL.	
	Examiner	Art Unit	
	Satwant K. Singh	2626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 15 December 2000.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 January 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>6/25/2001</u> <u>6/22/2001</u> | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-8, 10, 19, and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Taguchi (US 6,163,784).

3. Regarding Claim 1, Taguchi disclosed a method of automatically indexing a document comprising: feeding a plurality of untabbed sheets in the sheet path of a sheet handling device (range of pages of the document) (col. 4, lines 20-27); identifying selected ones of the sheets based upon a predefined criteria (tab data stored in memory) (col. 4, lines 5-13); and automatically appending a tab to the identified sheets (tab attached to the current printing page B are successively shifted by the same amount and printed) (col. 5, lines 9-18).

4. Regarding Claim 2, Taguchi discloses a method wherein the sheet handling device is a printer or photocopier (Fig. 1, printer 3).

5. Regarding Claim 3, Taguchi discloses a method, wherein the sheet path comprises the output receptacle of the sheet handling device (output area of the printer 3) (col. 4, lines 37-41).

6. Regarding Claim 4, Taguchi discloses a method, wherein automatically appending is performed by a tab appending device (Fig. 1, display/printout block 4) controlled by a computing device (Fig. 1, apparatus for controlling output of a document) (col. 3, lines 40-48).
7. Regarding Claim 5, Taguchi discloses a method, wherein the computing device is in communication with a central processing unit of a computer that hosts text editing software, or with a printing device, or a bar code reading device (Fig. 1, printer 3).
8. Regarding Claim 6, Taguchi discloses a method, further comprising identifying a location on the selected sheet where the tab is to be appended (position calculator 13) (col. 3, lines 57-61).
9. Regarding Claim 7, Taguchi discloses a method, wherein the location of the tab is determined by software after an analysis of the electronic version of the document (Fig. 2, area size calculator) (tabs attached based on document data) (co. 3, lines 49-67).
10. Regarding Claim 8, Taguchi discloses a method, wherein a user specifies the location of the tab using a software interface (position calculator) (col. 3, lines 57-61).
11. Regarding Claim 10, Taguchi discloses a method wherein on f the predefined criteria is a page number (specified page) (col. 3, lines 57-61).
12. Regarding Claim 19, Taguchi discloses an apparatus for automatically indexing a document comprising: a sheet handling device having a sheet path, wherein the document is fed through the sheet path (output area of the printer 3) (col. 4, lines 37-41). a computing device for identifying selected ones of the sheets in the sheet path (tab

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data stored in memory) (col. 4, lines 5-13); a sheet sensor in communication with the computing device (range of pages of the document) (col. 4, lines 20-27); and a tab appending mechanism, controlled by the computing device, for appending a tab to the selected sheet (tab attached to the current printing page B are successively shifted by the same amount and printed) (col. 5, lines 9-18).

13. Regarding Claim 20, Taguchi discloses an apparatus, wherein the computing device receives instructions from an external computing device having text editing capabilities, or from a printer or photocopier, or from a bar code reading device (Fig. 1, printer 3).

### ***Claim Rejections - 35 USC § 103***

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 9 and 11-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Taguchi in view of Eisenberg et al. (US 6,452,694).

16. Regarding Claim 9, Taguchi fails to teach a method, further comprising recording indicia on the tab to be appended to the selected sheet.

Eisenberg et al teach a method, further comprising recording indicia on the tab to be appended to the selected sheet (characters in the default index set are then applied automatically to tabs 22) (col. 6, lines 61-65).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Taguchi with the teaching of Eisenberg to print indicia on the tab to identify the tabbed pages and the identifying information.

17. Regarding Claim 11, Taguchi teaches a method, further comprising: identifying a location for appending the tab to the identified sheet (position calculator 13) (col. 3, lines 57-61).

Taguchi fails to teach a method, further comprising: printing indicia on the tab.

Eisenberg et al teach a method, further comprising: printing indicia on the tab (characters in the default index set are then applied automatically to tabs 22) (col. 6, lines 61-65).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Taguchi with the teaching of Eisenberg to print indicia on the tab to identify the tabbed pages and the identifying information.

18. Regarding Claim 12, Taguchi teaches a method of automatically indexing a document comprising: feeding a plurality of untabbed sheets in the sheet path of a printing device (range of pages of the document) (col. 4, lines 20-27); identifying selected ones of the sheets based upon a predefined criteria (tab data stored in memory) (col. 4, lines 5-13); automatically identifying locations for appending tabs to the identified selected sheets (tab data stored in memory) (col. 4, lines 5-13); and

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appending the tab to the identified selected sheets (tab attached to the current printing page B are successively shifted by the same amount and printed) (col. 5, lines 9-18).

Taguchi fails to teach a method of automatically indexing a document comprising: printing indicia on the tab, wherein the indicia is electronically stored.

Eisenberg teaches a method of automatically indexing a document comprising: printing indicia on the tab, wherein the indicia is electronically stored (characters in the default index set are then applied automatically to tabs 22) (col. 6, lines 61-65).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Taguchi with the teaching of Eisenberg to print indicia on the tab to identify the tabbed pages and the identifying information.

19. Regarding Claim 13, Taguchi teaches a method, wherein the printing device is a printer or a photocopier (Fig. 1, printer 3).

20. Regarding Claim 14, Taguchi teaches a method, wherein the sheet path of the printing device comprises the output receptacle of the printing device (output area of the printer 3) (col. 4, lines 37-41).

21. Regarding Claim 15, Taguchi teaches a method, wherein identifying selected ones of the sheets is performed by a computing device (Fig. 1, apparatus for controlling output of a document) (col. 3, lines 40-48), wherein the computing device is in communication with a central processing unit of a computer that hosts text editing software, or with a printer or photocopier, or with a bar code reading device (Fig. 1, printer 3).

22. Regarding Claim 16, Taguchi teaches a method, wherein identifying the location for appending the tab is determined by software analysis of the electronic version of the document (Fig. 2, area size calculator) (tabs attached based on document data) (co. 3, lines 49-67).

23. Regarding Claim 17, Taguchi fails to teach a method, wherein the indicia is generated with a software interface configured to allow a user to define or modify at least one characteristic of the indicia.

Eisenberg teaches a method, wherein the indicia is generated with a software interface configured to allow a user to define or modify at least one characteristic of the indicia (characters in the default index set are then applied automatically to tabs 22) (col. 6, lines 61-65).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Taguchi with the teaching of Eisenberg to print indicia on the tab to identify the tabbed pages and the identifying information.

24. Regarding Claim 18, Taguchi teaches a method, wherein one of the predefined criteria is a page number (specified page) (col. 3, lines 57-61).

25. Claims 21-32 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Taguchi in view of Matsuguchi (US 6,053,231).

26. Regarding Claim 21, Taguchi fails to teach an apparatus, wherein the tab appending mechanism comprises a tab dispensing mechanism controlled by the computing device.



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Matsuguchi teaches an apparatus, wherein the tab appending mechanism comprises a tab dispensing mechanism controlled by the computing device (Fig 9, CPU 272).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Eisenberg with the teaching of Matsuguchi to control the tab dispensing mechanism with the CPU.

27. Regarding Claim 22, Taguchi fails to teach an apparatus, wherein the tab dispensing mechanism comprises a roll of pre-cut tabs attached to a backing tape.

Matsuguchi teaches an apparatus, wherein the tab dispensing mechanism comprises a roll of pre-cut tabs attached to a backing tape (Fig. 7, label continuum 10) (col. 3, lines 35-42).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Taguchi with the teaching of Matsuguchi to control the tab dispensing mechanism with the CPU.

28. Regarding Claim 23, Taguchi fails to teach an apparatus, further comprising a device for recording indicia on the tab to be dispensed

Matsuguchi teaches an apparatus, further comprising a device for recording indicia on the tab to be dispensed (Fig. 9, thermal head 242) (col. 8, lines 11-32).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Taguchi with the teaching of Matsuguchi to control the printing of the information on the label with the CPU.

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29. Regarding Claim 24, Matsuguchi teaches an apparatus, wherein the device for recording indicia comprises a print head and an ink source.

Matsuguchi teaches an apparatus, wherein the device for recording indicia comprises a print head and an ink source (Fig. 9, thermal head 242) (col. 8, lines 11-32).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Taguchi with the teaching of Matsuguchi to control the printing of the information on the label with the CPU.

30. Regarding Claim 25, Taguchi fails to teach an apparatus, wherein the print head is selected from the group comprising: a laser printing device, an ink-jet printing device, a thermal resistive transfer printing device, and an impact printing device.

Matsuguchi teaches an apparatus, wherein the print head is selected from the group comprising: a laser printing device, an ink-jet printing device, a thermal resistive transfer printing device, and an impact printing device (Fig. 9, thermal head 242) (col. 8, lines 11-32).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Taguchi with the teaching of Matsuguchi to control the printing of the information on the label with the CPU.

31. Regarding Claim 26, Taguchi teaches an apparatus, wherein the apparatus is integrated with the sheet handling components of a printing device (output area of the printer 3) (col. 4, lines 37-41).

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32. Regarding Claim 27, Taguchi teaches an apparatus, wherein the printing device may be selected from the group comprising: a printer, a photocopier, and a typewriter (Fig. 1, printer 3).

33. Regarding Claim 28, Taguchi fails to teach an apparatus, wherein the apparatus is configured for use as an external accessory for use with a printing device.

Matsuguchi teaches an apparatus, wherein the apparatus is configured for use as an external accessory for use with a printing device (Fig. 9, output interface 276) (col. 9, lines 29-34).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Taguchi with the teaching of Matsuguchi to control the printing of the information on the label with the CPU.

34. Regarding Claim 29, Taguchi teaches an apparatus, wherein the apparatus is configured for use with the manual feeding of sheets (output area of the printer 3) (col. 4, lines 37-41).

35. Regarding Claim 30, Taguchi teaches an apparatus, wherein the computing device receives an indication of the location for appending the tab on the selected sheets position calculator 13) (col. 3, lines 57-61).

36. Regarding Claim 31, Taguchi teaches an apparatus, wherein the indication is provided by a user utilizing a software interface.

37. Regarding Claim 32, Taguchi teaches an apparatus, wherein the indication is provided by software analysis of an electronic version of the document.

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38. Regarding Claim 34, Taguchi teaches an apparatus for automatically indexing a document comprising: a printing device having a sheet path for delivering a document having printed, untabbed sheets (range of pages of the document) (col. 4, lines 20-27); a sheet sensor for detecting sheets in the sheet path of the printing device (tab data stored in memory) (col. 4, lines 5-13); a computing device, in communication with the sheet sensor, identifying selected ones of the printed, untabbed sheets (tab attached to the current printing page B are successively shifted by the same amount and printed) (col. 5, lines 9-18).

39. Taguchi fails to teach an apparatus for automatically indexing a document comprising: a tab dispensing device, controlled by the computing device, for appending tabs to the identified selected sheets; and a print head, controlled by the computing device and cooperating with the tab dispensing device, for recording indicia on the tabs.

Matsuguchi teaches an apparatus for automatically indexing a document comprising: a tab dispensing device, controlled by the computing device, for appending tabs to the identified selected sheets (Fig. 1, bonding apparatus, 300); and a print head, controlled by the computing device and cooperating with the tab dispensing device, for recording indicia on the tabs (Fig. 9, thermal head 242) (col. 8, lines 11-32).

40. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Taguchi with the teaching of Matsuguchi to allow a printer to apply a printed tab to a pre-defined pages of a document.

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41. Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Taguchi and Matsuguchi as applied to claim 24 above, and further in view of Eisenberg et al. (US 6,452,694).

42. Regarding Claim 33, Taguchi and Matsuguchi fail to teach an apparatus, wherein a user utilizes software configured to allow creation and modification of the indicia.

Eisenberg et al teach an apparatus, wherein a user utilizes software configured to allow creation and modification of the indicia (Fig. 1, computing system 10) (col. 6, lines 39-42).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Taguchi and Matsuguchi with the teaching of Eisenberg to allow the user to decide what to print on the tab.

43. Claim 35 is rejected under 35 U.S.C. 103(a) as being unpatentable over Taguchi (US 6,163,784) in view of Eisneberg et al. (US 6,452,694) and Matsuguchi (US 6,053,231).

44. Regarding Claim 35, Taguchi teaches an apparatus for automatically indexing a document comprising: a printing device Fig. 1, printer 3); means for detecting sheets in the output path of the printing device (range of pages of the document) (col. 4, lines 20-27); means for identifying selected ones of the sheets for receiving a tab, wherein the identifying means communicates electronically with the detecting means (tab data stored in memory) (col. 4, lines 5-13); means for indicating locations where the tabs are to be appended to the selected sheets (position calculator 13) (col. 3, lines 57-61);

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means for generating and communicating the location and indicia of the tabs to the selecting means (position calculator 13) (col. 3, lines 57-61).

45. Taguchi fails to teach an apparatus for automatically indexing a document comprising: means for creating and editing indicia to be recorded on the tabs; means for recording the indicia on the tabs, wherein the selecting means controls the recording means; and means for appending the tabs to the selected sheets, wherein the selecting means controls the appending means.

Eisenberg et al teach an apparatus for automatically indexing a document comprising: means for creating and editing indicia to be recorded on the tabs indicia (Fig. 1, computing system 10) (col. 6, lines 39-42); means for recording the indicia on the tabs, wherein the selecting means controls the recording means (characters in the default index set are then applied automatically to tabs 22) (col. 6, lines 61-65).

46. Matsuguchi teaches an apparatus for automatically indexing a document comprising: means for appending the tabs to the selected sheets, wherein the selecting means controls the appending means (label strip to be bonded to the object) (col. 10, lines 8-20).

### ***Conclusion***

47. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Kelley et al. (US 5,210,622) discloses an electronic reprographic printing system for printing on outputs sheets of a print job.

Hamilton (US 5,19,501) discloses a print system for printing on output sheets having a proof mode for proofing images requiring printing on tab stock.

Popat et al. (US 5,892,892) discloses a computer-printable adhesive note system.

Verhines (US 5,996,130) discloses a user printable tab sheet or card construction.

Hunter et al. (US 6,071,030) discloses a method for printing on index divider sheet assemblies and the like.

Pacione (US 6,193,457) discloses a printable file folder with custom label tab.

Owen et al. (US 6,361,639) discloses a method for manufacturing an index divider sheet assembly.

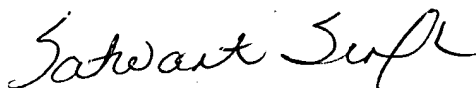
### ***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Satwant K. Singh whose telephone number is (571) 272-7468. The examiner can normally be reached on Monday thru Friday 8am - 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly A. Williams can be reached on (571) 272-7471. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

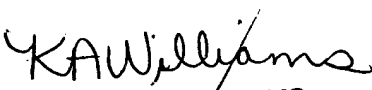
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sks

Satwant K. Singh  
Examiner  
Art Unit 2626



**KIMBERLY WILLIAMS**  
**SUPERVISORY PATENT EXAMINER**